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## Foreign Patent Decisions and Harmonization: A View of the Presumption against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

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FOREIGN PATENT DECISIONS AND HARMONIZATION: A VIEW OF THE PRESUMPTION  
AGAINST GIVING FOREIGN PATENT DECISIONS PRECLUSIVE EFFECT IN UNITED STATES  
PROCEEDINGS IN LIGHT OF PATENT LAW INTERNATIONAL HARMONIZATION

DR. ROBERTO ROSAS

I. INTRODUCTION.....	2
II. THE TERRITORIAL NATURE OF PATENTS.....	3
A. Patent Validity, Intrinsic and Extrinsic Evidence.....	5
III. FOREIGN DECISIONS IN U.S. PATENT PROCEEDINGS .....	8
A. General Considerations .....	8
B. Case Law – A presumption against giving preclusive effect to foreign patent decisions. ....	11
1. Court of Customs and Patent Appeals .....	11
2. Federal Circuit .....	12
C. The Presumption Against Giving Preclusive Effect to Foreign Patent Decision Might Be Overcome if Relevance Is Shown. ....	14
1. Relevance of Foreign Patent Prosecution and Statements .....	14
2. Relevance in the General Context .....	15
IV. THE HARMONIZATION OF UNITED STATES PATENT LAW AND THE WORLD .....	18
A. Paris Convention .....	19
B. Patent Cooperation Treaty .....	19
C. Trade-Related Aspects of Intellectual Property .....	23
D. The America Invents Act.....	24
E. Differences with Respect to Patentability .....	25
V. CONCLUSION.....	26

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I. INTRODUCTION

Simply put, a patent is a monopoly granted to an inventor in exchange for disclosure of his invention to the public; no one can make, sell, or use the invention without the owner's consent.<sup>1</sup> However, it is a well-known proposition that a patent is territorial in nature, and it only prevents infringement within the territory of the sovereign country granting it.<sup>2</sup> This presents a problem in today's world, given the rapid globalization of markets.<sup>3</sup> As a result, inventors generally apply for patent protection in more than one country, in order to protect their invention everywhere.<sup>4</sup> And so the norm in today's world is that where there is a United States patent, there are also likely multiple foreign counterpart patents. Armed with a patent, a holder can then move to stop others from infringing on his invention, and more often than not, the defendant will argue that the United States patent is invalid,<sup>5</sup> often citing

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<sup>1</sup> See 35 U.S.C.A. § 154 (West 2012) (discussing the scope of patents); *Patents: What is a Patent*, USPTO.GOV, <http://www.uspto.gov/inventors/patents.jsp> (last visited March 19, 2018) (explaining the definition of a United States patent).

<sup>2</sup> See 35 U.S.C.A. § 271 (West 2012) (making it very clear that the protection afforded only applies "within the United States"); Eric Chan, *Asserting Foreign Patent Claims in United States Federal Courts: What's Left After Voda v. Cordis?*, 18 ALB. L.J. SCI. & TECH. 1 (2008) (emphasizing the territorial nature of patents); Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 137 (1997) (stating that "patents are territorial by nature"); Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 521 (1997) (citing *Brown v. Duchesne*, 60 U.S. 183 (1857) (pointing out that courts have held patents to be territorial in nature even before the patent statute was enacted)), Decision confirmed in part reversed in part by *Nat'l Fed'n of Indep. Bus. v. Sebelius*, 567 U.S. 519 (2012). Pending Legislation that proposes amendments to 35 U.S.C.A. § 271: 2017 S. 771, 2017 S. 812, 2017 S. 1390, 2017 H.R. 1776, 2017 H.R. 1879.

<sup>3</sup> See Andrew S. Kerns, *Fight or Flight: Traversing the Extraterritorial Battlefield of Modern United States Patent Law*, 63 BAYLOR L. REV. 462, 462 (2011) (discussing economic globalization and expanding access to markets); see also Y. Liu, *Patenting Business Methods in the United States and Beyond—Globalization of Intellectual Property Protection is Not Always an Easy Game to Play*, 42 IIC INT'L R. OF INTELL. PROP. & COMPETITION L. 395 (2011) (noting the globalization of intellectual property).

<sup>4</sup> See Andrew S. Kerns, *Fight or Flight: Traversing the Extraterritorial Battlefield of Modern United States Patent Law*, 63 BAYLOR L. REV. 462, 465 (2011) (noting that patent holders tend to apply for protection of the same invention in several countries); see also Eric Chan, *Asserting Foreign Patent Claims in United States Federal Courts: What's Left After Voda v. Cordis?*, 18 ALB. L.J. SCI. & TECH. 1, 4-8 (2008) (discussing the implications of applying for patents in different countries); *United States Courts*, 93 VA. L. REV. 1259, 1295-96 (2007) (explaining the difficulties with multinational patents).

<sup>5</sup> See 35 U.S.C.A. § 282 (West 2012) (listing counterclaim of patent invalidity as a defense to a patent infringement action); Devon Curtis Beane, *Whose Right Is It Anyway?: The Evisceration of an*

foreign decisions and proceedings in support of that claim. Given the territorial nature of patents and the fact that countries have different requirements and standards for granting patents,<sup>6</sup> United States courts have applied a presumption against giving preclusive effect to foreign patent decisions.<sup>7</sup> But the courts have made clear that the presumption is a consequence of the differences in the patent law of different countries. The courts, therefore, seem willing and able to consider foreign decisions in United States proceedings. Given the ongoing efforts to harmonize United States patent laws with the patent laws of the rest of the world in order to meet the globalization of markets, whether the presumption against giving preclusive effect to foreign patent decisions will survive in its current form is very much an open question. This comment discusses this topic in four parts. Part II offers a view of the traditional territorial nature of patents. Part III discusses how courts currently approach foreign patent decisions in United States proceedings and takes a look at the presumption against giving them preclusive effect. Part IV analyzes the harmonization efforts that have taken place and that are taking place in order to bring United States patent law in line with the rest of the world.

## II. THE TERRITORIAL NATURE OF PATENTS

Obtaining a patent is simple, albeit not easy at all.<sup>8</sup> An applicant has to but meet the requirements of the United States Patents and Trademarks Office (USPTO) to obtain a patent.<sup>9</sup> Of course that is far easier said than done.<sup>10</sup> Nonetheless once obtained, a patent then gives the holder exclusive use of the invention, for a limited

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*Infringer's Seventh Amendment Right in Patent Litigation*, 2011 U. ILL. L. REV. 1853, 1860 (2011) (noting that a patent infringer can assert a counterclaim that the Patent and Trademark Office erroneously issued the patent, making it invalid); Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1788 (1997) (highlighting the fact that patent invalidity is a defense commonly raised in actions for patent infringement).

<sup>6</sup> See Eric Chan, *Asserting Foreign Patent Claims in United States Federal Courts: What's Left After Voda v. Cordis?*, 18 ALB. L.J. SCI. & TECH. 1, 4-8 (2007) (discussing the implications of applying for patents in different countries); Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 136 (1997) (noting that the requirements of patents vary from country to country); See generally Kendra Robins, *Extraterritorial Patent Enforcement and Multinational Patent Litigation: Proposed Guidelines for United States Courts*, 93 VA. L. REV. 1259, 1295-96 (2007) (explaining the positive and negative implications of multinational patents); See generally Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 521 (1997) (discussing the impact of territoriality on patents and patent decisions).

<sup>7</sup> See discussion *infra* notes 60-93 and accompanying text.

<sup>8</sup> See *How to Get a Patent*, USPTO.GOV, <http://www.uspto.gov/web/patents/howtopat.htm> (last visited March 19, 2018) (discussing in simple terms the requirements to obtain a patent); Devon Curtis Beane, *Whose Right Is It An Evisceration of the Infringer's Seventh Amendment Right in Patent Litigation*, 2011 U. ILL. L. REV. 1853, 1859 (2011) (explaining the patent process).

<sup>9</sup> See 35 U.S.C.A. § 101-123 (West 2012) (detailing the requirements for obtaining a patent); see also *How to Get a Patent*, USPTO.GOV, <http://www.uspto.gov/web/patents/howtopat.htm> (last visited March 19, 2018) (discussing in simple terms the requirements to obtain a patent).

<sup>10</sup> See Gene Quinn, *The Cost of Obtaining a Patent in the US*, IP WATCHDOG (April 4, 2015) <http://www.ipwatchdog.com/2015/04/04/the-cost-of-obtaining-a-patent-in-the-us/id=56485/> (discussing the intricacies and difficulties in obtaining a patent).

period of time, in exchange for disclosing the invention in full to the public.<sup>11</sup> Although the exclusive right to use the invention is not absolute, it does give the holder remedies when the patent is infringed upon.<sup>12</sup> However, the protection afforded by a patent exists only “within the United States”.<sup>13</sup> The Supreme Court was clear about that fact in *Microsoft v. AT&T Corporation*, stating that “under United States patent law . . . , no infringement occurs when a patented product is made and sold in another country.”<sup>14</sup> The same applies to patents issued in other countries.<sup>15</sup> That is to say, a patent issued by a country offers protection only within the territory of that country. This means that if a holder wants to enforce his patent, he must bring an action in each country where there is infringement.<sup>16</sup> And so the norm in today’s world is that where there is a United States patent, there are also likely multiple foreign counterpart patents, containing identical or nearly identical claims. Therefore, it could be said that obtaining a patent is only the beginning; the true value of a patent is on whether it can be enforced.<sup>17</sup>

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<sup>11</sup> See 35 U.S.C.A. § 154 (West 2012) (discussing the scope of patents); Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1791 (1997) (explaining the scope of a patent grant).

<sup>12</sup> See 35 U.S.C.A. § 271-273 (West 2012).

<sup>13</sup> 35 U.S.C.A. § 271 (West 2012); see Eric Chan, *Asserting Foreign Patent Claims in United States Federal Courts: What's Left After Voda v. Cordis?*, 18 ALB. L.J. SCI. & TECH. 1 (2008) (emphasizing the territorial nature of patents); Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 137 (1997) (stating that “patents are territorial by nature”). Pending Legislation that proposes amendments to 35 U.S.C.A § 271: 2017 S. 771, 2017 S. 812, 2017 S. 1390, 2017 H.R. 1776, 2017 H.R. 1879

<sup>14</sup> *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 441 (2007); see 35 U.S.C.A § 271 (West 2012) (making it clear that the protection only applies “within the United States”); Andrew S. Kerns, *Fight or Flight: Traversing the Extraterritorial Battlefield of Modern United States Patent Law*, 63 BAYLOR L. REV. 462, 474 (2011) (discussing the limits of United States patent law) but see Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 522-23 (1997) (noting the limited circumstances in which courts have given extraterritorial effect to United States patent law), Supreme Court: distinguished by *Life Techs. Corp. v. Promega Corp.*, 137 S.Ct. 734 (2017) (distinguishing based on factual differences, but not finding *Microsoft Corp. v. AT&T Corp.* to be “to the contrary”); Fifth Circuit District Court: distinguished in *Honeywell Int'l, Inc. v. Acer Am. Corp.*, 655 F.Supp.2d 650 (E.D. Tex. 2009) (distinguished based on factual differences); Ninth Circuit District Court: distinguished in and followed by *Veritas Operating Corp. v. Microsoft Corps.*, 562 F.Supp.2d (W.D. Wash. 2008); Federal Circuit: distinguished by *TianRui Group Co. v. ITC*, 661 F.3d 1322 (Fed. Cir. 2011).

<sup>15</sup> See generally Timothy R. Holbrook, *Extraterritoriality in United States Patent Law*, 49 WM. & MARY L. REV. 2119, 2124 (2008) (discussing the need for harmonization among the various patent laws of different countries); *Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 704 (2004) (suggesting that the patent territoriality is decreasing in vigor and power).

<sup>16</sup> See generally Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 137-38 (1997) (lamenting the hindrance due to the territorial nature of patents resulting in varying laws from country to country).

<sup>17</sup> See Devon Curtis Beane, *Whose Right Is It Anyway?: The Evisceration of an Infringer's Seventh Amendment Right in Patent Litigation*, 2011 U. ILL. L. REV. 1853, 1859 (2011) (discussing the two-fold patent process: obtaining a patent, and enforcing a patent); see also 35 U.S.C.A. § 271-273 (West 2012) (stating what constitutes patent infringement).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

*A. Patent Validity, Intrinsic and Extrinsic Evidence*

United States Patent law gives the patent holder a civil cause of action “for infringement of his patent.”<sup>18</sup> And although it also gives a presumption of patent validity,<sup>19</sup> it nonetheless lists a number of defenses that can be asserted to defeat that presumption.<sup>20</sup> The most often used defense is that of patent invalidity.<sup>21</sup> A party asserting the defense of invalidity would claim that the United States Patent and Trademark Office issued the patent despite the fact that it did not meet all the elements required for a patent to be granted.<sup>22</sup> A successful defense of invalidity has the effect of making the patent invalid, and the patent holder can no longer enforce against the defendant, or anyone else.<sup>23</sup> Therefore, a patent must be able withstand a challenge to its presumption of validity.<sup>24</sup>

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<sup>18</sup> 35 U.S.C.A. § 281 (West 2012).

<sup>19</sup> See 35 U.S.C.A. § 282 (West 2012) (stating that a “patent shall be presumed valid”).

<sup>20</sup> See 35 U.S.C.A. § 282 (West 2012). It provides in part that:

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

- 1) Noninfringement, absence of liability for infringement or unenforceability.
- 2) Invalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability.
- 3) Invalidity of the patent or any claim in suit for failure to comply with—
  - a. any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or
  - b. any requirement of section 251.
- 4) Any other fact or act made a defense by this title.

<sup>21</sup> 35 U.S.C.A. § 282 (West 2012) (listing counterclaim of patent invalidity as a defense to a patent infringement action); Devon Curtis Beane, *Whose Right Is It Anyway?: The Evisceration of an Infringer's Seventh Amendment Right in Patent Litigation*, 2011 U. ILL. L. REV. 1853, 1860 (2011) (noting that an infringer can assert a counterclaim that the Patent and Trademarks Office erroneously issued the patent, making it invalid); Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1788 (1997) (highlighting the fact that patent invalidity is a defense commonly raised in actions for patent infringement);

The courts have long recognized the importance eliminating invalid patents. See *Blonder Tongue Lab. v. Univ. of Ill.*, 402 U.S. 313 (1971) The courts have long recognized the importance eliminating invalid patents.

<sup>22</sup> See generally 35 U.S.C.A. § 101-123 (West 2012) (detailing the requirements for obtaining a patent); see also *How to Get a Patent*, USPTO.GOV, <http://www.uspto.gov/web/patents/howtopat.htm> (last visited March 19, 2018) (discussing in simple terms the requirements to obtain a patent).

<sup>23</sup> See Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 714 (2004) (suggesting that the effect of holding a patent invalid is that there is no patent); Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1805 (1997) (discussing the effect of a patent invalidity declaration).

<sup>24</sup> Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1791-92 (1997) (stating “The United States Patent and Trademark Office issues a patent when a patent application meets three major statutory requirements. First, an invention must fit into one of the statutory classes of subject matter allowed for a patent and have utility. Second, the invention must be novel, and it must not be obvious. Finally, the patent application must fully describe the invention (the description requirement) so that others can make and use it (the enablement requirement); set out the best mode known to the inventor for carrying out the invention; and have a claim that clearly sets out the metes and bounds of the patented invention.”).

The Supreme Court in *Markman v. Westview Instruments, Inc.* stated that in its simple form, an action for patent infringement consists of two steps: “construing the patent and determining whether infringement has occurred”<sup>25</sup> The Court also noted that the first question, the claim construction question, is a question of law “to be determined by the court, . . .” and “[t]he second is a question of fact, to be submitted to a jury.”<sup>26</sup> When answering claim construction questions, the Court first looks at the words of the claim.<sup>27</sup> The words of the claim include such intrinsic evidence as the patent claims,<sup>28</sup> the specification,<sup>29</sup> and prosecution history.<sup>30</sup> Although the scope of this comment is limited to the specification, all three types of intrinsic evidence play an important role in claims construction by the court. The requirements of the specification are found in 35 U.S.C.A. § 112<sup>31</sup> and are held to require three disclosures: a written description, enablement, and a best mode.<sup>32</sup> The purpose of these requirements is to try to avoid the possibility of any ambiguity in the patent.<sup>33</sup>

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<sup>25</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996). Supreme Court: distinguished in *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); Followed and Explained by *Teva Pharms. USA, Inc. v. Sandoz, Inc.* 135 S. Ct. 831 (2015); Supreme Court: followed by *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014).

<sup>26</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

<sup>27</sup> See *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995)), *aff'd* 517 U.S. 370 (1996) (stating that in claims construction, the court first looks at “the patent itself, including the claims, the specification and, if in evidence, the prosecution history”); Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 714 (2004) (discussing the process of claim construction); Sixth Circuit District Court: *Norgren Auto., Inc. v. SMC Corp. of Am.*, 261 F.Supp.2d 910 (E.D. Mich. 2003); Seventh Circuit District Court: distinguished in part and followed in part *Ashland Prods., Inc. v. MEC Techs., Inc.*, No. 9 C 4436, 1999 U.S. Dist. LEXIS 4087 (N.D. Ill. Mar. 22 1999); Ninth Circuit District Court: distinguished by *Smith & Nephew, Inc. v. Arthrex, Inc.*, 603 F. Appx 981 (Fed. Cir. 2015); Tenth Circuit: distinguished by *Xlear, Inc. v. STS Health, LLC*, No. 2:14-CV-00806-DN, 2015 U.S. Dist. LEXIS 167707 (D. Utah Dec. 14, 2015); Fed Circuit: distinguished by *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364 (Fed. Cir. 2003).

<sup>28</sup> See 35 U.S.C.A. § 112 (West 2012) (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention”).

<sup>29</sup> See *Id.* (“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”).

<sup>30</sup> See *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) *aff'd*, 517 U.S. 370 (1996)).

<sup>31</sup> 35 U.S.C.A. § 112 (West 2012).

<sup>32</sup> *Id.* (“The specification shall contain a *written description* of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to *enable any person skilled in the art* to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the *best mode contemplated by the inventor* or joint inventor of carrying out the invention” (emphasis added)).

<sup>33</sup> See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (reasoning that if “the patent’s claims are sufficiently unambiguous for the Patent and Trademarks Office, there should exist no factual ambiguity when those same claims are later construed by a court of law in an infringement action”).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

In addition to considering intrinsic evidence in the construction, a court may also consider extrinsic evidence<sup>34</sup> when constructing the meaning of a claim.<sup>35</sup> However, as useful as extrinsic evidence might be,<sup>36</sup> reliance on extrinsic evidence over intrinsic evidence is not allowed.<sup>37</sup> If the meaning of the terms is clear and unambiguous, extrinsic evidence may not be used to vary or contradict that clear meaning.<sup>38</sup> It is then clear that, when it comes to claim construction in a patent infringement action, intrinsic evidence has priority over extrinsic evidence.

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<sup>34</sup> See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995) *aff'd*, 517 U.S. 370 (1996) (stating that extrinsic evidence is “all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises”).

<sup>35</sup> See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) (citing *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996) (noting that considering extrinsic evidence is not prohibited when constructing claims)); Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 715 (2004) (explaining that considering extrinsic evidence is only appropriate if there remains ambiguity in the claim after reviewing the intrinsic evidence).

<sup>36</sup> See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (citing *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1584 (Fed.Cir.1996) (stating that “it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field”)); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (citing *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (Extrinsic evidence might also be used to aid a judge in interpreting the intricate and technical aspects of the claim, “from the vantage point of one skilled in the art.”)).

<sup>37</sup> See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (holding that it is error for a court to rely on extrinsic evidence that directly contradicts intrinsic evidence); Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 715 (2004) (explaining that considering extrinsic evidence, “is only appropriate if, after reviewing the intrinsic evidence, there is an ambiguity in the claim”).

<sup>38</sup> See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (holding that it is error for a court to rely on extrinsic evidence that directly contradicts intrinsic evidence); Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 715 (2004) (explaining that considering extrinsic evidence, “is only appropriate if, after reviewing the intrinsic evidence, there is an ambiguity in the claim”).



### III. FOREIGN DECISIONS IN U.S. PATENT PROCEEDINGS

#### A. General Considerations

For a while now, United States courts have been applying foreign law in domestic patent cases.<sup>39</sup> And although courts do so within certain limits,<sup>40</sup> the practice remains controversial<sup>41</sup> with some calling for the total ban of the application of a foreign country's law in domestic cases.<sup>42</sup> In fact, Arkansas, Arizona, Louisiana, Kansas, Mississippi, North Carolina, Oklahoma, South Dakota, and Washington all have laws or statutes that explicitly prohibit the application of foreign law in their courts.<sup>43</sup> It is

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<sup>39</sup> See *Washington v. Glucksberg*, 521 U.S. 702, 734 (1997) (citing the Dutch law in respect to physician-assisted suicide); *Atkins v. Virginia*, 536 U.S. 304, 316 n.21 (2002) (referring to the “world community” disapproval of the imposition of the death penalty for crimes committed by mentally retarded offenders); *Foster v. Florida*, 537 U.S. 990, 992 (2002) (Breyer, J., dissenting) (pointing out the law of other nations); see also Steven G. Calabresi & Stephanie Dotson Zimdahl, *The Supreme Court and Foreign Sources of Law: Two Hundred Years of Practice and the Juvenile Death Penalty Decision*, 47 WM. & MARY L. REV. 743 (2005) (noting that the Supreme Court has for a while now been citing to transnational law in constitutional cases); Eugene Volokh, *Foreign Law in American Courts*, 66 OKLA. L. REV. 219 (2017) (discussing that foreign law is routinely used in United States courts); Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 576 (1997) (noting that it is not unusual for United States court to apply the law of foreign countries). Supreme Court: distinguished by *Obergefell v. Hodges*, 135 S. Ct. 2584 (2015). Fourth Circuit District Court: criticized in part by and followed by *Struniak v. Lynch*, 159 F.Supp. 3d 643 (E.D. Va. 2016) (believing *Obergefell* to be a rejection of the strict requirements that were set forth in *Glucksberg*). Seventh Circuit District Court: criticized by and distinguished by *Wolf v. Walker*, 986 F.Supp.2d 982 (W.D. Wis. 2014).

<sup>40</sup> See Eugene Volokh, *Foreign Law in American Courts*, 66 OKLA. L. REV. 219 (2017) (discussing the controversy over the use of foreign law to interpret the United States constitution); Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 576 (1997) (noting that United States courts generally refuse the application of foreign law in cases involving foreign revenue, penal laws, and foreign laws); *Privilege and Foreign Privilege Laws in United States Patent Litigation*, 23 SANTA CLARA COMPUTER & HIGH TECH. L.J. 667, 677 (2007) (discussing the principle of comity and its impact when applying foreign law).

<sup>41</sup> See Austen L. Parrish, *Storm in a Tea Cup: The United States Supreme Court's Use of Foreign Law*, 2007 U. ILL. L. REV. 637, 638 (2007) (discussing the debate centered around the United States Supreme Court's application and citation to foreign law).

<sup>42</sup> See Bruce Schreiner, *Bill Would Ban Courts From Using Foreign Law*, NEWS OBSERVER, (Apr. 11, 2011) <http://www.newsobserver.com/2011/04/28/1159062/bill-would-ban-courts-from-using.html> (reporting that a bill introduced to Congress would ban foreign laws from being applied in court); see also Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 581 (2012) (noting that that debate on the application of foreign patent law has led to discussions about completely banning references to non-United States law by courts).

<sup>43</sup> Ala. Const. art. I § 13.50 (Alabama's state constitution amendment concerning the application of foreign law); Ark. Code Ann. § 1-1-103 (West 2018) (Arkansas' policy regarding the application of a foreign law, legal code, or system); Ariz. Rev. Stat. Ann. § 12-3102 (West 2018) (Arizona's prohibition against the enforcement of foreign law); La. Stat. Ann. § 9:6001 (West 2010) (Louisiana's policy on the application of foreign law); Kan. Stat. Ann. § 60-5103 (West 2018) (Kansas' policy that a ruling or decision by any court, arbitration, tribunal or administrative agency that is based on foreign law is void and unenforceable); Miss. Code Ann. § 11-63-1 (West 2015) (Mississippi's policy on the application of foreign laws in judicial proceedings); N.C. Gen. Stat. Ann. § 1-87.13 (West 2018) (North Carolina's public policy regarding the use and application of foreign law); Okla. Stat. Ann. tit. 12, § 20 (West 2013) (Oklahoma's prohibition on the use of foreign law); Tenn. Code Ann. § 20-15-102 (West 2010) (Tennessee actually considers granting comity to foreign decisions.).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

difficult to say whether the trend is toward more acceptance of the application of foreign law, or if more states are against it.<sup>44</sup>

It is important at this stage of our discussion to note there are two ways in which a court can recognize foreign law decisions: *enforcement* and *recognition*.<sup>45</sup> *Enforcement* generally entails the execution of a money judgment while. *Recognition*, however, might require the court to give *res judicata* and collateral estoppel effect to the foreign law decisions.<sup>46</sup> Recognition of foreign decisions is governed by principles of comity.<sup>47</sup> Therefore, United States courts will recognize foreign judgments as a matter of comity if the courts decide that the matter has been decided by a foreign court with sufficient finality and does not want to litigate it further.<sup>48</sup> But the principle of comity does not require the court to apply the foreign judgment in its entirety.<sup>49</sup> The court may apply only those matters within the judgment that it deems to be enforceable and refuse to enforce those which the court deems are not enforceable.<sup>50</sup>

Despite the intensity of the debate, application of foreign law in the area of intellectual property has not been significantly referenced.<sup>51</sup> This is perhaps due to the fact that the vast majority of the changes to domestic patent law are a result of obligations with other countries.<sup>52</sup> In that sense, the extent of the applicability of foreign law and foreign decisions to United States patent litigation is still a somewhat open question. A clear answer to that question, however, is very important, given the internationalization of intellectual property law.<sup>53</sup> Some have pointed out the

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<sup>44</sup> See *Ortman v. Stanray Corp.*, 371 F.2d 154, 159 (7th Cir. 1967) (“[T]he current trend is toward readier enforcement of claims arising under foreign laws.”); Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 582-83 (2012) (stating that “[o]ne important caveat: foreign law should not dictate domestic United States law, but it can helpfully inform it. Moreover, when issues of the extraterritorial application of United States patent law arise, in those contexts consideration of foreign law is quite important to avoid conflicts of law. The benefits of such consideration that can flow to the United States include a form of soft-harmonization, where United States courts, after appraising themselves of foreign law, may adopt or be influenced by that law if they find it persuasive. In such cases, the barriers to trade and commerce that differing intellectual property standards can create will be reduced. Such consideration may then lead to international norms of patent law.”).

<sup>45</sup> See *Victrix Steamship Co., S.A. v. Salen Dry Cargo A.B.*, 65 B.R. 466, 470 (S.D.N.Y. 1986), *aff’d*, 825 F.2d 709 (2d Cir. 1987) (noting that the “recognition [of a judgment] is not the same as the enforcement of the judgment”).

<sup>46</sup> See *Id.* (explaining the difference between recognition and enforcement).

<sup>47</sup> See *Victrix Steamship Co., S.A. v. Salen Dry Cargo A.B.*, 65 B.R. 466 (S.D.N.Y. 1986), *aff’d*, 825 F.2d 709 (2d Cir. 1987) (explaining that comity governs the effect given to foreign judgments).

<sup>48</sup> See Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT’L L. 135, 156 (1997) (explaining the effect of comity on a foreign judgment).

<sup>49</sup> See *Id.*

<sup>50</sup> See *Id.*

<sup>51</sup> See Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 581 (2012) (stating that the debate about whether application of foreign law to United States proceedings is proper “has not referenced intellectual property law”).

<sup>52</sup> See *Id.* (noting that almost all of the changes to United States intellectual property law stem from an effort to harmonize our laws to those of our foreign trading partners); See *eg.*, AGREEMENT ON TRADE-RELATED ASPECTS OF INTELL. PROP. RIGHTS, art. 3, Apr. 15, 1994 1869 U.N.T.S. 299 (1994) (discussing the obligations and responsibilities under Trade-Related Aspects Intellectual Property Rights).

<sup>53</sup> See Y. Liu, *Patenting Business Methods in the United States and Beyond—Globalization of Intellectual Property Protection is Not Always an Easy Game to Play*, 42 IIC INT’L R. OF INTELL. PROP. & COMPETITION L. 395 (2011) (noting the globalization of intellectual property); see also Timothy R.

necessity of harmonizing the global patent system, considering the vast number of disharmonious and incompatible patent systems around the world.<sup>54</sup> As some commentators have noted, the “practice of intellectual property law, and patent law in particular, is effectively a practice in international law in the modern era.”<sup>55</sup> To that end, the United States has long considered not only international obligations<sup>56</sup> but also international activities when considering United States patent policy.<sup>57</sup> Some courts have already stepped out of the bounds of the traditional territoriality of patents and decided that where the foreign law and the United States law are sufficiently related, the court can adjudicate a foreign patent.<sup>58</sup> But it is important to note that courts have taken a different approach when considering the relevance of foreign patent decisions regarding patent validity, and when considering the relevance of foreign patent histories. In regards to foreign decisions of patent validity the Federal Circuit, has consistently highlighted the fact that patent laws vary from country to country and has repeatedly declined to adopt the conclusions of foreign tribunals when making patent determinations of validity.<sup>59</sup>

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Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 704 (2004) (suggesting that the territorial nature of a patent is losing vigor and power).

<sup>54</sup> See Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 Hous. J. INT'L L. 125, 126 (2008) (discussing the need of harmonization in the global patent system). See generally *F. Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164-65 (2004) (noting the responsibility of the courts to ensure that “conflicting laws of different nations work together in harmony- a harmony particularly needed in today's highly interdependent commercial world.”).

<sup>55</sup> Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 582 (2012).

<sup>56</sup> See *Id.* at 581 (noting the effect of international obligations on U.S. patent law); See eg., Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 3, Apr. 15, 1994, 1869 U.N.T.S. 299 (1994) (discussing patent law obligations under Trade-Related Aspects of Intellectual Property Rights).

<sup>57</sup> See Timothy R. Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 706-23 (2004) (discussing foreign activities that the United States patent law has had to confront).

<sup>58</sup> *Distillers Co. Ltd. v. Standard Oil Co.*, 10 Fed. R. Serv. 2d 373 (N.D. Ohio 1964); *But see Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, 1373-74 (Fed. Cir. 1994) (holding that 28 U.S.C. § 1338, which grants district courts jurisdiction over actions arising under any act of Congress relating to patents, does not extend to foreign patents). Therefore, “patent holder must find another source of jurisdiction to bring its claims for infringement of foreign patents against any alleged infringer.” Andrew S. Kerns, *Fight or Flight: Traversing the Extraterritorial Battlefield of Modern United States Patent Law*, 63 BAYLOR L. REV. 462, 462 (2011); See generally Kendra Robins, *Extraterritorial Patent Enforcement and Multinational Patent Litigation: Proposed Guidelines for United States Courts*, 93 VA. L. REV. 1259, 1279 (2007).

<sup>59</sup> See discussion *infra* notes 60-93 and accompanying text.

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

*B. Case Law – A presumption against giving preclusive effect to foreign patent decisions.*

*1. Court of Customs and Patent Appeals*

From the early cases in the Court of Customs and Patent Appeals (CCPA), The Federal Circuit predecessor, the Court has refused to give recognition to foreign judgments in terms of patent validity, holding those judgments to be irrelevant to United States patent proceedings because of the differences between the patent laws of the different countries. One of the earliest cases to address this issue was *In re Guinot*<sup>60</sup> in which the Court of Customs and Patent Appeals was presented with a German patent decision involving a German counterpart to the United States patent.<sup>61</sup> The Court declined to consider the German patent decision and noted that “in view of the fact that the German patent system may be quite different in its legal aspects from that of the United States, we feel that [the German decision] should not affect our conclusion here.”<sup>62</sup> Almost forty years later, the Court of Customs and Patent Appeals, in *In re Dulberg*,<sup>63</sup> refused to “even consider the actions taken in foreign countries with regard to the patentability of this application under our law.”<sup>64</sup> In regard to the question of obviousness, the Court of Customs and Patent Appeals noted the fact that a foreign patent has been granted for a particular invention has no relevance on the same invention is obvious under United States law.<sup>65</sup> However, the Court of Customs and Patent Appeals again emphasized the fact that its decision was, at least in part, based on the concern that “it is notoriously well known that the standards of patentability *vary from country to country*.”

In line with the Court of Customs and Patent Appeals, early Circuit Courts’ cases begin to show, although only in broad terms, the same reluctance to apply foreign decisions to United States cases regarding questions of patent validity due to varying laws.<sup>66</sup> In *Deep Welding, Inc. v. Sciaky Bros., Inc.*,<sup>67</sup> the Seventh Circuit Court noted when determining the validity of a particular patent, it would not look to foreign cases.<sup>68</sup> Similarly, although more to the point, the Eighth Circuit in *Ditto, Inc. v. Minnesota Mining & Mfg. Co.*<sup>69</sup> refused to recognize a German decision invalidating a

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<sup>60</sup> *In re Guinot*, 22 C.C.P.A. 1067 (C.C.P.A. 1935).

<sup>61</sup> *See Id.*

<sup>62</sup> *See Id.* at 1070 (emphasis added).

<sup>63</sup> *In re Application of Dulberg*, 472 F.2d 1394 (U.S. C.C.P.A. 1973). Second Circuit District Court: distinguished by *Windsurfing Int’l v. Fred Ostermann GmbH*, 668 F.Supp. 812 (S.D.N.Y. 1987).

<sup>64</sup> *In re Application of Dulberg*, 472 F.2d 1394, 1398 (C.C.P.A. 1973).

<sup>65</sup> *See Id.* (“The granting of a patent on an ‘invention’ in a foreign country has no relevance to the determination of whether the same ‘invention’ would be obvious within the ambit of § 103”).

<sup>66</sup> *But see* Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT’L L. 135, 160 (1997) (explaining that some Court of Appeals and District Court decisions have “held patents to be invalid after noting similar decisions by the German and Dutch patent offices concerning the same patents”).

<sup>67</sup> *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1234 (7th Cir. 1969).

<sup>68</sup> *See Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1234 (7th Cir. 1969) (stating that “we must determine the question of [patent] validity on the basis of the record before us and not as it has been litigated in other cases in domestic and foreign fora”).

<sup>69</sup> *Ditto, Inc. v. Minnesota Mining & Mfg. Co.*, 336 F.2d 67 (8th Cir. 1964).

German patent, counterpart to the United States patent in question.<sup>70</sup> In *Ditto*, the court expressed concern that “German law may well apply different standards from those controlling here and in all probability some difference exists in the expert testimony used in the cases.”<sup>71</sup> The same concern in the different standards between countries has led the Federal Circuit to hold that a United States court cannot be bound by the patent decision of a foreign proceeding.<sup>72</sup>

## 2. Federal Circuit

The Federal Circuit began to address the issue of the relevance of foreign decisions of patent validity in the case of *Stein Associates, Inc. v. Heat and Control, Inc.*<sup>73</sup> In *Stein*, the Federal Circuit was asked to enjoin a party from pursuing an action in Britain for infringement of British patents based on the theory that the counterpart United States patents were invalid.<sup>74</sup> The Federal Circuit denied the injunction noting that although a court “has the discretionary power to enjoin a party from pursuing litigation before a foreign tribunal”, it can “exercise that power only if the parties and issues are the same, and resolution of the domestic action will dispose of the foreign action.”<sup>75</sup> The Federal Court then held that the issues in *Stein* were not the same and so the injunction was denied.<sup>76</sup> Although the situation in *Stein* was not exactly on point to our discussion, namely the relevance of foreign decisions to United States litigation, the case does highlight the Federal Circuit concern with the fact that law vary from country to country.<sup>77</sup> The first case on point to our discussion came in 1986, in *Medtronic, Inc. v. Daig Corp.*,<sup>78</sup> where the Federal Circuit found that the patent decision of a foreign tribunal was not preclusive.<sup>79</sup> The defendant in *Medtronic* argued that since a foreign tribunal had found a patent obvious (and therefore invalid), the

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<sup>70</sup> See *Id.* at 71 (explaining that the German decision of invalidity, although well-reasoned, did not control here).

<sup>71</sup> *Id.*

<sup>72</sup> See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1994) (taking “notice of the fact that the theories and laws of patentability vary from country to country, as do examination practices” and noting that “international uniformity in theory and practice has not been achieved.”); See generally J. Scott Larson, *Excessive Harmonization of International Patent Prosecution May Strike Discord in Patent Litigation*, 22 INTELL. PROP. & TECH. L.J. 6 (2010) (discussing the reason why some United States courts refuse to admit foreign patent-law-related decisions in United States cases).

<sup>73</sup> *Stein Associates, Inc. v. Heat and Control, Inc.*, 748 F.2d 653 (Fed. Cir. 1984).

<sup>74</sup> See *Id.* at 657-58 (explaining the infringing defendant’s theory that once the United States patent is invalidated, all counterpart foreign patents are also found to be invalid).

<sup>75</sup> *Stein Associates, Inc. v. Heat and Control, Inc.*, 748 F.2d 653, 658 (Fed. Cir. 1984).

<sup>76</sup> *Id.*

<sup>77</sup> See *Id.* (stating that “British law being different from our own, and British and United States courts being independent of each other, resolution of the question of whether the United States patents are valid could have no binding effect on the British court’s decision”); see also J. Scott Larson, *Excessive Harmonization of International Patent Prosecution May Strike Discord in Patent Litigation*, 22 INTELL. PROP. & TECH. L.J. 6 (2010) (discussing the reason why some United States courts refuse to admit foreign patent-law-related decisions in United States cases).

<sup>78</sup> *Medtronic, Inc. v. Daig Corp.*, 789 F.2d 903 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 931 (1986).

<sup>79</sup> See *Id.* at 907-908.

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

United States counterpart patent should also be found obvious and therefore invalid.<sup>80</sup> The Federal Circuit rejected that argument going so far as to characterize the defendant's argument as "specious".<sup>81</sup> However, in denying the defendant's argument, the court cited *In re Application of Larsen*,<sup>82</sup> in which the Court of Customs and Patent Appeals, its predecessor, held that "in view of the differences between foreign patent laws and those of the United States, the allowance of patent claims in foreign countries is not pertinent to the question whether similar claims should be allowed here."<sup>83</sup> Again, the court repeated its concern over the differences between foreign and United States patent laws. Most recently in *Glaxo Group Ltd. v. Apotex, Inc.*,<sup>84</sup> a defendant in a patent infringement suit argued that a decision made in a Canadian court of non-infringement of the Canadian counterpart to the US patent-in-suit should control.<sup>85</sup> Although the Federal Circuit found non-infringement, the Court explicitly noted its conclusion that "the Canadian judgment construing the Canadian patent and applying Canadian patent law does not control . . .".<sup>86</sup> In *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*,<sup>87</sup> the Federal Circuit criticized the district court's placement of great weight on a European rejection in a foreign patent application to determine obviousness<sup>88</sup> under 35 U.S.C. §103.<sup>89</sup> The Federal Circuit again emphasized the differences in patent laws between countries.<sup>90</sup> Interestingly however, the Federal Circuit seemed to lament the fact that international uniformity of patent laws is not yet a reality.<sup>91</sup> In that sense, it seems that the Federal Circuit has not closed the door completely on the relevance of foreign decisions to United States

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<sup>80</sup> See *Id.* at 908.

<sup>81</sup> See *Id.* at 907-908.

<sup>82</sup> *In re Application of Larsen*, 292 F.2d 531 (C.C.P.A. 1961). Court of Customs & Patent Appeals: validity questioned by *In re Kuehl*, 475 F.2d 658 (C.C.A. 1973); distinguished in *In re Mancy*, 499 F.2d 1289 (C.C.A. 1974); Seventh Circuit District Court: distinguished by *Deere & Co. v. Int'l Harvester Co.*, 460 F.Supp. 523 (S.D. Ill. 1978).

<sup>83</sup> *In re Application of Larsen*, 292 F.2d 531, 533 (C.C.P.A. 1961).

<sup>84</sup> *Glaxo Group Ltd. v. Apotex, Inc.*, 64 F. App'x. 751 (Fed. Cir. 2003) (nonprecedential).

<sup>85</sup> See *Id.* at 755 n1 (explaining the defendant's theory).

<sup>86</sup> *Glaxo Group Ltd. v. Apotex, Inc.*, 64 F. App'x. 751, 755 n1 (Fed. Cir. 2003) (nonprecedential).

<sup>87</sup> *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1994).

<sup>88</sup> See 23 *A.L.R. Fed.* 326 (Originally published in 1975) for a great discussion on the requirement of "non-obviousness". "Obviousness of a patent is a question of law based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the prior art and the claimed invention; and (4) the extent of any objective indicia of non-obviousness." *Crocs, Inc. v. International Trade Com'n*, 598 F.3d 1294 (Fed. Cir. 2010).

<sup>89</sup> See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072 n2 (Fed. Cir. 1994).

<sup>90</sup> See *Id.* (taking "notice of the fact that the theories and laws of patentability vary from country to country, as do examination practices.").

<sup>91</sup> See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072 n2 (Fed. Cir. 1994) (urging "caution when applying the action of a foreign patent examiner to deciding whether the requirements of 35 U.S.C. §103 are met under United States law, for international uniformity in theory and practice has not been achieved."); see also Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 137-38 (1997) (lamenting the hindrance due to the territorial nature of patents resulting in varying laws from country to country).

judicial proceedings.<sup>92</sup> It is perhaps only waiting for the global patent regime to become more harmonized.<sup>93</sup>

*C. The Presumption Against Giving Preclusive Effect to Foreign Patent Decision Might Be Overcome if Relevance Is Shown.*

*1. Relevance of Foreign Patent Prosecution and Statements*

Although the Federal Circuit has repeatedly and consistently declined to adopt the conclusions of foreign tribunals because of the variance in the law between different countries, it has not precluded every piece of evidence from a foreign procedure if it is shown that the evidence is actually relevant.<sup>94</sup> One such example of foreign evidence that has been found to be relevant in United States proceeding is foreign prosecution history.<sup>95</sup> One of the first cases to address the role of foreign

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<sup>92</sup> See *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, 2005 WL 3525681 (D. Del. 2005) (noting that the Federal Circuit has not endorsed a *per se* rule against the admission of foreign law decisions). Affirmed in Part, Reversed in Part and Remanded in *Pfizer, Inc. v. Ranbaxy Lab. Ltd.*, 457 F.3d 1284 (Fed. Cir. 2006).

<sup>93</sup> Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581 (2012).

“Almost all of the changes to domestic, United States intellectual property law flow from international obligations or efforts to harmonize our laws with those of our trading partners. Changes in intellectual property law that have their genesis in international law or harmonization concerns include changing the patent term from seventeen years from issuance to twenty years from the application date; extension of United States copyrights to life of the author plus seventy years; restoration of copyright protection for foreign works; the inclusion of offering to sell and importing the invention as forms of infringement; publication of most United States patent applications after eighteen months; addition of protection of process patents based solely on the sale of the product of the patented process; mitigation of discriminatory treatment of foreign inventors based on foreign inventive activities; and recognition of priority for foreign applications for trademarks and patents. The practice of intellectual property law, and patent law in particular, is effectively a practice in international law in the modern era.”

<sup>94</sup> See *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, 2005 WL 3525681, 3 (D. Del. 2005) (explaining that the Federal Circuit has not endorsed a “per se exclusion of evidence related to foreign patent prosecutions”); See *eg.* *TI Grp. Auto. Sys. (N. Am.), Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1136 (Fed. Cir. 2004) (noting only that varying laws might render evidence from a foreign tribunal inappropriate but refusing to endorse a *per se* rule); *Tanabe Seiyaku Co., Ltd. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 733 (Fed. Cir. 1997) (explaining that evidence from a foreign procedures should be considered when it is relevant to the present proceeding); *Caterpillar Tractor Co. v. Berco, S.P.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983) (stating that even though there is not authority “for the proposition that instructions to foreign counsel and a representation to foreign patent offices should be considered, and the varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representations inappropriate, there is ample such authority in decisions of other courts and when such matters comprise relevant evidence they must be considered.”).

<sup>95</sup> See *Tanabe Seiyaku Co., Ltd. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 733 (Fed. Cir. 1997) (explaining that foreign prosecution history should be considered in domestic proceedings when it is relevant); See *generally* *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (stating the claims must be construed in light of the specification and the patent’s prosecution history, if in evidence).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

prosecution history in United States cases was *Caterpillar Tractor Co. v. Berco, S.P.A.*<sup>96</sup> In *Caterpillar*, a defendant on a patent infringement case contended that the Plaintiff had, by statements made to foreign patent offices, had limited its own United States patent.<sup>97</sup> The Federal Circuit, in holding the district court finding of infringement, noted that although there was no authority advising United States courts to consider foreign prosecution history,<sup>98</sup> prosecution history should be considered when it contains relevant evidence to the case at hand.<sup>99</sup> Although the Federal Circuit emphasized the fact that patent prosecution procedures differ from country to country but in foreign countries, it nonetheless allowed foreign prosecution history because it found it to be relevant.<sup>100</sup> More recently in *Tanabe Seiyaku Co., Ltd. v. U.S. Int'l Trade Comm'n*,<sup>101</sup> the Federal Circuit upheld the finding of the International Trade Commission in regards to infringement of Tanabe's patent.<sup>102</sup> The International Trade commission relied on statements made by Tanabe during its United States, Finland, Israel, and European Patent Office patent prosecution.<sup>103</sup> Tanabe argued to the Federal Circuit that the International Trade Commission's reliance on patent prosecution statements made to foreign patent offices was not erroneous.<sup>104</sup> The Federal Circuit held that when evaluating infringement, representations to foreign patent offices should be considered when they are relevant.<sup>105</sup> Although the Federal Circuit's finding in *Caterpillar* and *Tanabe* might apply narrowly,<sup>106</sup> it nonetheless highlights the Federal Circuit's willingness to consider foreign proceedings and give them weight when it is relevant and appropriate.

## 2. Relevance in the General Context

In a more general context (i.e. outside the context of foreign prosecution history and statements), the Courts have largely followed the Federal Circuit's approach. In rejecting a defendant's argument that a Canadian Patent Office rejection of the counterpart patent rendered the United States patent invalid, the Sixth Circuit court in *Skil Corp. v. Lucerne Products, Inc.*,<sup>107</sup> reasoned simply that patent proceedings in other countries do not control in United States proceedings.<sup>108</sup> Citing an earlier decision from the Second Circuit,<sup>109</sup> the court emphasized that the reason, in part,

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<sup>96</sup> *Caterpillar Tractor Co. v. Berco, S.P.A.*, 714 F.2d 1110 (Fed. Cir. 1983).

<sup>97</sup> *Id.*, at 1116.

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Caterpillar Tractor Co. v. Berco, S.P.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983).

<sup>101</sup> *Tanabe Seiyaku Co., Ltd. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726 (Fed. Cir. 1997).

<sup>102</sup> *See Id.*, at 731 (discussing that the ITC found no infringement).

<sup>103</sup> *Id.*, at 730.

<sup>104</sup> *Id.*, at 733.

<sup>105</sup> *Tanabe Seiyaku Co., Ltd. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 733 (Fed. Cir. 1997).

<sup>106</sup> *See generally* Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 594 (2012) (citing the cases standing for the proposition that prosecution histories of related patents in foreign countries are admissible and highly probative in United States proceedings).

<sup>107</sup> *Skil Corp. v. Lucerne Prods., Inc.*, 684 F.2d 346 (6th Cir. 1982).

<sup>108</sup> *Id.*, at 351.

<sup>109</sup> *Timely Prods. Corp. v. Arron*, 523 F.2d 288, 295 (2d Cir. 1975). Supreme Court: criticized in *Pfaff v. Wells Elecs.*, 525 U.S. 55 (1998).



foreign patent law proceedings do not control is “because standards of patentability vary widely from country to country.”<sup>110</sup> The Court also noted that “no evidence was introduced showing that in 1965 Canadian patent law was substantially identical to United States patent law or that the facts and circumstances surrounding the two applications were substantially identical”<sup>111</sup> and concluded based on that fact, that “the proceedings in *Skil*’s Canadian application did not overcome the enhanced presumption of validity attaching to the [U.S] patent.”<sup>112</sup> Although the Sixth Circuit held the Canadian patent decision irrelevant, or at least no controlling in the United States court, the Sixth Circuit does seem to indicate that the presumption of validity of the United States patent could be overcome by a foreign patent decision, if relevance is demonstrated by the party moving to introduce the foreign patent law decision.<sup>113</sup> Similarly in *In re Yarn Processing Patent Validity Litigation*,<sup>114</sup> the Fifth Circuit reversed the district court’s use of a Canadian decision because the Circuit court decided that Canadian law was different from United States law.<sup>115</sup>

District courts have also followed the approach of the Federal Circuit. Early on after *Caterpillar*,<sup>116</sup> the district court in *Vas-Cath, Inc. v. Mahurkar* reasoned that the patents-in-suit covered the same invention and that Canadian patent law presented no significant differences from United States patent law.<sup>117</sup> Based on those considerations, the district court employed a Canadian patent decision to preclude further litigation of certain issues in the United States patent suit<sup>118</sup>. However, on appeal, the Federal Circuit reversed on other grounds, and obviated consideration of the district court’s reliance on the Canadian judgment.<sup>119</sup>

In *Cuno, Inc. v. Pall Corp.*, the district court concluded that “[w]here the prior adjudication was by a foreign nation’s court applying its patent law to its patents, the barriers to reliance on the foreign judgment for collateral estoppel purposes become almost insurmountable.”<sup>120</sup> However, the court then noted that prior case law specifically focuses on the differences in patent laws between countries.<sup>121</sup> Noting that British law is different than United States law, the district court in *Cuno* decided that it was bound by prior law to exclude a British patent decision from United States litigation.<sup>122</sup>

In *Pfizer Inc. v. Ranbaxy Laboratories Ltd.*,<sup>123</sup> the district court denied a patentee’s motion, and allowed the introduction of a determination by a foreign patent office that

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<sup>110</sup> *Skil Corp. v. Lucerne Prods., Inc.*, 684 F.2d 346, 351 n3 (6th Cir. 1982).

<sup>111</sup> *Skil Corp. v. Lucerne Prods., Inc.*, 684 F.2d 346, 351 (6th Cir. 1982).

<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974).

<sup>115</sup> See *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271, 279 (5th Cir. 1974) (discussing the difference between the United States law and the Canadian law in question).

<sup>116</sup> *Caterpillar Tractor Co. v. Berco, S.P.A.*, 714 F.2d 1110 (Fed. Cir. 1983).

<sup>117</sup> *Vas-Cath, Inc. v. Mahurkar*, 745 F. Supp. 517, 525 (N.D. Ill 1990), *rev’d*, *Vas-Cath Inc. v. Sakharam D. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

<sup>118</sup> *Vas-Cath, Inc. v. Mahurkar*, 745 F. Supp. 517, 525 (N.D. Ill 1990), *rev’d*, 935 F.2d 1555 (Fed. Cir. 1991).

<sup>119</sup> *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991), *rev’g*, 745 F. Supp. 517.

<sup>120</sup> *Cuno, Inc. v. Pall Corp.*, 729 F. Supp. 234, 238 (E.D.N.Y. 1989).

<sup>121</sup> *Id.*, at 238-39.

<sup>122</sup> *Id.*, at 239.

<sup>123</sup> *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, No. 03-209-JJF, 2005 WL 3525681 (D. Del. 2005).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

the claims in the foreign counterpart patent were invalid.<sup>124</sup> The district court basis for that decision was in line with the Federal Circuit's precedent, namely that the evidence could have some relevance.<sup>125</sup> The district court reasoned that "[t]he Federal Circuit does not endorse the per se exclusion of evidence related to foreign patent prosecutions. Rather, the Federal Circuit has recognized that such matters may be relevant in certain circumstances."<sup>126</sup> On subsequent appeal, the Federal Circuit affirmed the district court's decision.<sup>127</sup>

In *PharmaStem Therapeutics, Inc. v. Viacell Inc.*<sup>128</sup> the defendant attempted to introduce a European Patent Office decision of invalidity against a counterpart United States patent.<sup>129</sup> In rejecting the defendant's motion, the district court stated that "an opinion, although of a quasi-judicial or administrative body and albeit that of a foreign jurisdiction, carries with it a certain imprimatur, which creates a substantial risk that the jury will give its conclusions undue deference. Even if the jury is instructed to consider the opinion for its limited purposes, there is a strong likelihood that the jury would be confused as to its relevance."<sup>130</sup> Even though it rejected the European Patent Office's decision, the court in *PharmaStem* did so based on the prejudicial effect of the decision. Presumably, had the court found less prejudicial effect, the court might have considered the foreign decision.

In *Oki Am. v. Advanced Micro Devices, Inc.*, the court specifically held that the "action taken by the European Patent Office rejecting . . . counterpart application over the same . . . reference is neither controlling nor persuasive."<sup>131</sup> The court reasoned that on questions of patent validity, United States courts do not defer to foreign decisions.<sup>132</sup>

In *ActiveVideo Networks, Inc. v. Verizon Communications, Inc.*,<sup>133</sup> the district court excluded evidence of proceedings before the International Trade Commission regarding the asserted patents and proceedings before foreign patent offices on related counterpart patents.<sup>134</sup> Although the court excluded the foreign law decision, it did so because it found that the relevance of evidence relating to the prosecution of foreign counterpart patents was outweighed by the danger of that evidence being unduly

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<sup>124</sup> *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, No. 03-209-JJF, 2005 WL 3525681, 3 (D. Del. 2005).

<sup>125</sup> *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, No. 03-209-JJF, 2005 WL 3525681, 3 (D. Del. 2005).

<sup>126</sup> *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, No. 03-209-JJF, 2005 WL 3525681, 3 (D. Del. 2005).

<sup>127</sup> *Pfizer, Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284 (Fed. Cir. 2006).

<sup>128</sup> *PharmaStem Therapeutics, Inc. v. Viacell Inc.*, No. 02-148 GMS, 2003 U.S. Dist. LEXIS 17137 (D. Del. 2003).

<sup>129</sup> *PharmaStem Therapeutics, Inc. v. Viacell Inc.*, No. 02-148 GMS, 2003 U.S. Dist. LEXIS 17137 \*9 (D. Del. 2003). Affirmed in Part, Reversed in Part by *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007).

<sup>130</sup> *PharmaStem Therapeutics, Inc. v. Viacell Inc.*, No. 02-148 GMS, 2003 U.S. Dist. LEXIS 17137 \*9 (D. Del. 2003).

<sup>131</sup> *Oki Am. v. Advanced Micro Devices, Inc.*, No. C 04-03171, 2006 U.S. Dist. LEXIS 82654 (N.D. Cal. Nov. 13, 2006).

<sup>132</sup> *Oki Am. v. Advanced Micro Devices, Inc.*, No. C 04-03171, 2006 U.S. Dist. LEXIS 82654 \*25 n.2 (N.D. Cal. Nov. 13, 2006).

<sup>133</sup> *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 2011 WL 7036048 (E.D. Va. 2011). Affirmed in Part, Reversed in Part by *ActiveVideo Networks, Inc. v. Verizon Communications, Inc.*, 694 F.3d 1312 (Fed. Cir. 2012).

<sup>134</sup> *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 2011 WL 7036048, \*2 (E.D. Va. 2011).

prejudicial.<sup>135</sup> Of note in this decision is the fact that the court did find relevance on the foreign decision, however it was not enough to give it a preclusive effect.<sup>136</sup>

More recently, however, in *Pexcor Mfg. Co., Inc v. Uponor AB*<sup>137</sup> the district court granted a stay of a patent invalidity declaratory judgment action brought by a Canadian corporation in United States court, pending the resolution of a case in Canada over the counterpart Canadian patents.<sup>138</sup> The court pointed out that even though Canadian patent law is different from United States patent law, “a decision in Canada about the parties’ rights under a ‘nearly identical’ patent likely will narrow the issues and possibly will resolve this case.”<sup>139</sup> The court then reasoned that it had discretionary authority to stay the United States case pending a decision in the Canadian litigation.<sup>140</sup> In an attempt to avoid a complex, time-consuming, and costly litigation, the court granted the stay.<sup>141</sup> This case illustrates the willingness of courts to consider foreign decisions, even when they recognize the difference in the patent law of each country. This is perhaps a result of the modern trend of globalization of patent law.<sup>142</sup>

#### IV. THE HARMONIZATION OF UNITED STATES PATENT LAW AND THE WORLD

It is clear that most, if not all, changes to United States patent law have been the in response to requirements imposed by international agreements.<sup>143</sup> This has led to a higher than ever level of harmonization between the United States and the rest of world, and is resulting in a sort of international system of patents.<sup>144</sup> The harmonization of United States and international patent law is especially significant

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<sup>135</sup> *Id.*

<sup>136</sup> *Id.*

<sup>137</sup> *Pexcor Mfg. Co., Inc. v. Uponor AB*, CIV.A. 11-2034 RMC, 2013 WL 416296 (D.D.C. Feb. 4, 2013).

<sup>138</sup> *Id.* at 2.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> *Pexcor Mfg. Co., Inc. v. Uponor AB*, CIV.A. 11-2034 RMC, 2013 WL 416296, 2 (D.D.C. Feb. 4, 2013).

<sup>142</sup> See Timothy R. Holbrook, *Territoriality waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701, 704 (2004) (suggesting that the patent law is becoming more global); see also Timothy R. Holbrook, *Extraterritoriality in United States Patent Law*, 49 WM. & MARY L. REV. 2119, 2124 (2008) (discussing the need for harmonization among the various patent laws of countries); See generally Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT’L L. 135, 137-38 (1997) (lamenting the hindrance due to the territorial nature of patents resulting in varying and distinct laws from country to country).

<sup>143</sup> See Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 581 (2012) (noting that almost all of the changes to United States intellectual property law stem from a sincere effort to harmonize our laws to those of our trading partners); See eg., Agreement on Trade-Related Aspects of Intell. Prop. Rights, art. 3, Apr. 15, 1994, 1869 U.N.T.S. 299 (1994) (discussing the obligations under Trade-Related Aspects of Intellectual Property Rights).

<sup>144</sup> See J. Scott Larson, *Excessive Harmonization of International Patent Prosecution May Strike Discord in Patent Litigation*, 22 INTELL. PROP. & TECH. L.J. 6, 7 (2010) (explaining the international movement toward greater patent system harmonization); John R. Thomas, *Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement*, 27 L. & POL’Y INT’L BUS. 277, 288 (1996) (discussing the strong pace of international harmonization in patent law).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

in light of the Federal Court's statement in *Heidelberger*.<sup>145</sup> The Federal Circuit in *Heidelberger* refused to give preclusive effect to a foreign decision because of the difference in the patent law between the United States and other countries, and lamented the reason behind that fact: that international harmonization has not been achieved.<sup>146</sup> It may not be unreasonable to envision a level of international harmonization that may be enough for the Federal Circuit to allow it to reverse the presumption against giving foreign decisions preclusive effect in United States proceedings. To that end, a discussion of international harmonization efforts to date is appropriate.

### A. Paris Convention

The first attempt at international harmonization came in the *Paris Convention for the Protection of Industrial Property*.<sup>147</sup> One of the obligations imposed upon member countries under the *Paris Convention* is that member countries must provide national treatment to applicants of fellow member countries.<sup>148</sup> The result of the national treatment requirement is that if a patent applicant files in the United States and subsequently decides to file in another member country, the applicant will receive the earlier United States priority filing date, if the subsequent application is made within twelve months.<sup>149</sup> This gives the applicant up to one year to decide in which country to apply for the patent, and advances the harmonization of the international patent regime.

### B. Patent Cooperation Treaty

The second significant international attempt at patent harmonization was the Patent Cooperation Treaty (PCT).<sup>150</sup> Under the Patent Cooperation Treaty, a patent

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<sup>145</sup> *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068 (Fed. Cir. 1994).

<sup>146</sup> *Id.* at 1071.

<sup>147</sup> *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, 21 U.S.T. 1583; *see also* *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, T.I.A.S. No. 6923, 6 INT'L LEGAL MATERIALS 806 (enabling the protection for patents and trademarks by setting minimum standards among the member countries for industrial property protection).

<sup>148</sup> *See* *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, 21 U.S.T. 1583; *see* *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, 828 U.N.T.S. 305; Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 136 (2008) (discussing the Paris conventions national treatment requirement).

<sup>149</sup> *See* *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, 21 U.S.T. 1583; *Paris Convention for the Protection of Industrial Property*, Mar. 20, 1883, T.I.A.S. No. 6923; Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 583 (2012) (explaining the national treatment requirement under the Paris Convention); Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 136 (2008) (discussing the Paris conventions national treatment requirement).

<sup>150</sup> *Patent Cooperation Treaty*, June 19, 1970, 28 U.S.T. 7645; *see also* WIPO-Administered Treaties, WORLD INTEL. PROP. ORG., [www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=6](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=6) (last visited Aug. 3, 2018) (showing the text of the Patent Cooperation Treaty).

applicant can secure a patent filing date by filing in any member country and designating any other member country.<sup>151</sup> The effect is that an applicant can obtain the benefit of a filing date in the United States without ever setting foot in the United States.<sup>152</sup> Conversely, an applicant can obtain the benefit of a filing date in another member country without ever setting foot in that country.<sup>153</sup> The Patent Cooperation Treaty also sets forth a framework under which a search and examination is conducted on the application by an International Searching Authority, which results in a search report that lists citations and documents relevant to the patentability of the application.<sup>154</sup> Under the Patent Cooperation Treaty, the International Searching

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<sup>151</sup> See Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 137 (2008) (discussing the requirements of the Patent Cooperation Treaty); *Summary of the Patent Cooperation Treaty*, WORLD INTELL. PROP. ORG., [http://www.wipo.int/treaties/en/registration/pct/summary\\_pct.html](http://www.wipo.int/treaties/en/registration/pct/summary_pct.html) (last visited Aug. 3, 2018) (summarizing the treaty and stating "the Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an "international" patent application. Such an application may be filed by anyone who is a national or resident of a PCT Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva.

If the applicant is a national or resident of a Contracting State party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the Bangui Agreement, or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Intellectual Property Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

The Treaty regulates in detail the formal requirements with which international applications must comply.

Filing a PCT application has the effect of automatically designating all Contracting States bound by the PCT on the international filing date. The effect of the international application is the same in each designated State as if a national patent application had been filed with the national patent office of that State.").

<sup>152</sup> See Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645, 1160 U.N.T.S. 231; WIPO-Administered Treaties, WORLD INTELL. PROP. ORG., [www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=6](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=6) (last visited August 3, 2018); Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 137 (2008) (discussing the benefits afforded to applicants by the Patent Cooperation Treaty).

<sup>153</sup> See Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645; WIPO-Administered Treaties, WORLD INTELL. PROP. ORG., [www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=6](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=6) (last visited Aug. 3, 2018); Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 137 (2008) (discussing the benefits afforded to applicants by the Patent Cooperation Treaty).

<sup>154</sup> See Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645; *Summary of the Patent Cooperation Treaty*, WORLD INTELL. PROP. ORG., [http://www.wipo.int/treaties/en/registration/pct/summary\\_pct.html](http://www.wipo.int/treaties/en/registration/pct/summary_pct.html) (last visited Aug. 3, 2018) ("The international application is subjected to an international search. That search is carried out by one of the competent International Searching Authorities (ISA) under the PCT . . . and results in an international search report"); *Summary of the Patent Cooperation Treaty*, WORLD INTELL. PROP. ORG., [http://www.wipo.int/treaties/en/registration/pct/summary\\_pct.html#\\_ftn1](http://www.wipo.int/treaties/en/registration/pct/summary_pct.html#_ftn1) (last visited Aug. 3, 2018) (also noting that "[t]he patent offices of Australia, Austria, Brazil, Canada, Chile, China, Egypt, Finland, India, Israel, Japan, the Republic of Korea, the Russian Federation, Singapore, Spain, Sweden, Turkey, Ukraine, the United States of America, the European Patent Office, the Nordic Patent Institute and the Visegrad Patent Institute act as International Searching Authorities under

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

Authority also issues a written opinion in which the International Searching Authority provides an opinion with respect to patentability of the application.<sup>155</sup> The examiner's written opinion is not binding upon member countries, but in practice, the written opinion is instructive and a number of member countries rely heavily upon the written opinion in their own examination.<sup>156</sup> Although the Patent Cooperation Treaty does not create a truly global patent regime, it does contribute to the harmonization of international patent law because it provides a streamlined and simplified process for patent applications in multiple countries.<sup>157</sup>

Recently, a new collaborative program related to the Patent Cooperation Treaty was announced by the USPTO.<sup>158</sup> The PCT Collaborative Search and Examination Pilot is a program that is intended to further harmonize the international patent examination framework by addressing the international work sharing between jurisdiction and "streamlining examination and search procedures for patent examiners in multiple countries."<sup>159</sup> Under the PCT Collaborative Search and Examination Pilot, examiners from the IP5 offices<sup>160</sup> collaborate with one another on

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the PCT (status on July 1, 2018). An agreement enabling the office of the Philippines to act as ISA has been signed; however, this office has not yet commenced operations.").

<sup>155</sup> See Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645; *Summary of the Patent Cooperation Treaty*, WORLD INTELL. PROP. ORG., [http://www.wipo.int/treaties/en/registration/pct/summary\\_pct.html](http://www.wipo.int/treaties/en/registration/pct/summary_pct.html) (last visited Aug. 3, 2018) ("In addition, a preliminary and non-binding written opinion on whether the invention appears to meet patentability criteria in light of the search report results is also issued.").

<sup>156</sup> See *Id.* ("In addition, a preliminary and non-binding written opinion on whether the invention appears to meet patentability criteria in light of the search report results is also issued").

<sup>157</sup> See Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT'L L. 125, 137 (2008) (discussing the impact of the Patent Cooperation Treaty on the international harmonization of patent law);

For a discussion about many other benefits derived from the Patent Cooperation Treaty, refer to J. Scott Larson, *Excessive Harmonization of International Patent Prosecution May Strike Discord in Patent Litigation*, 22 INTELL. PROP. & TECH. L.J. 6, 10-11 (2010).

<sup>158</sup> Patent and Trademark Office, *Patent Cooperation Treaty Collaborative Search and Examination Pilot Project Between the IP5 Offices*, 83 FED. REG. 30145, 30146-30147 (June 27, 2018) (announcing the PCT Collaborative Search and Examination Pilot); PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018) (announcing and explaining the scope of the PCT Collaborative Search and Examination Pilot).

<sup>159</sup> PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018) ("The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single "international" patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent offices in what is called the "national phase". The PCT Collaborative Search and Examination (CS&E) Pilot improves international work sharing even further by streamlining examination and search procedures for patent examiners in multiple countries").

<sup>160</sup> Patent and Trademark Office, *Patent Cooperation Treaty Collaborative Search and Examination Pilot Project Between the IP5 Offices*, 83 FED. REG. 30145 (June 27, 2018) (stating that "[t]he United States Patent and Trademark Office (USPTO), the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO) and the State Intellectual Property Office of the People's Republic of China (SIPO), [are] referred to collectively as the IP5 Offices"); About IP5 co-operation, FIVEIPOFFICES, <http://www.fiveipoffices.org/about.html> (last visited Aug. 3, 2018) (naming the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of

the search and examination of a single application.<sup>161</sup> “The result is an international search report (ISR) and written opinion (WO) from the chosen International Searching Authority (ISA) based on contributions from all participating offices.”<sup>162</sup> Although the ISR and WO that result from the PCT Collaborative Search and Examination Pilot are not binding on the individual members designated on the application, the collaborative nature of the ISR and WO in the PCT Collaborative Search and Examination Pilot has the benefit of a higher predictability of the outcome when the examination in the individual member countries is conducted.<sup>163</sup> Although the PCT Collaborative Search and Examination Pilot is a temporary program, it is another example of the ongoing harmonization efforts in the international patent framework.<sup>164</sup>

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China (SIPO), and the United States Patent and Trademark Office (USPTO), as the five members of the IP5).

<sup>161</sup> See PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018) (“The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single “international” patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent offices in what is called the “national phase”. The PCT Collaborative Search and Examination (CS&E) Pilot improves international work sharing even further by streamlining examination and search procedures for patent examiners in multiple countries”); Patent and Trademark Office, *Patent Cooperation Treaty Collaborative Search and Examination Pilot Project Between the IP5 Offices*, 83 FED. REG. 30145 (June 27, 2018) (setting forth the scope, procedure, and purpose of the PCT Collaborative Search and Examination Pilot framework).

<sup>162</sup> PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018).

<sup>163</sup> See PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018) (setting forth the search by multiple examiners with different language capabilities, the increased predictability of outcome, and the lack of extra cost as the benefits of the PCT Collaborative Search and Examination Pilot); Patent and Trademark Office, *Patent Cooperation Treaty Collaborative Search and Examination Pilot Project Between the IP5 Offices*, 83 FED. REG. 30145 (June 27, 2018) (setting forth the scope, procedure, and purpose of the PCT Collaborative Search and Examination Pilot framework).

<sup>164</sup> Patent and Trademark Office, *Patent Cooperation Treaty Collaborative Search and Examination Pilot Project Between the IP5 Offices*, 83 FED. REG. 30145 (June 27, 2018) (“The pilot project is divided into two phases, a preparatory phase and an operational phase. The preparatory phase started on June 2, 2016 and was dedicated to the administrative and practical preparations required for a smooth functioning of the pilot. The operational phase will start on July 1, 2018 and will be dedicated to the processing of applications under the collaborative scheme, the monitoring of applications for evaluation purposes, and the assessment of the outcome of the pilot. The operational phase will last for a period of three years ending on July 1, 2021 and will include an evaluation of the impact of the pilot on examination during the subsequent national/regional stages. Requests for participation in the pilot will be accepted only during the first two years of the operational phase, i.e., from July 1, 2018, to June 30, 2020.”); PCT Collaborative Search and Examination Pilot, U.S. PAT. & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-collaborative> (last visited Aug. 3, 2018) (noting July 1, 2018 as the start date of the PCT Collaborative Search and Examination Pilot and explaining that the PCT Collaborative Search and Examination Pilot is a three year pilot, with the first two years as the operational phase and the third year being used to study the impact in the national phase).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

*C. Trade-Related Aspects of Intellectual Property*

Another advance in the international harmonization of patent law came with the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS).<sup>165</sup> As has been pointed out, the purpose of the Trade-Related Aspects of Intellectual Property was to “achieve a certain level of harmonization internationally by establishing minimum standards of intellectual property protection.”<sup>166</sup> It accomplished its objective by that by actually imposing substantive law requirements on member countries.<sup>167</sup> To comply with Trade-Related Aspects of Intellectual Property Rights requirements, Congress amended 35 U.S.C.A. § 271(a) in 1993.<sup>168</sup> As a consequence of Trade-Related Aspects of Intellectual Property Rights stated purpose of worldwide patent law harmonization, the Federal Circuit in *Rotec* engaged in a comparative analysis of the United Kingdom’s definition of infringement and the United States’.<sup>169</sup> The Federal Circuit disagreed with the United Kingdom’s interpretation of infringement.<sup>170</sup> Nonetheless, *Rotec* once again shows that the Federal Circuit is willing and able to consider foreign law and decisions in its analysis of United States patent law.

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<sup>165</sup> Agreement on Trade-Related Aspects of Intell. Prop. Rights, art. 3, Apr. 15, 1994, 1869 U.N.T.S. 299 (1994); (the Trade-Related Aspects of Intellectual Property Rights originated from General Agreements on Tariffs and Trade and is annex Information Center of the World Trade Organization Agreement (January 1, 1995), date in which World Trade Organization was established, as a consequence of the signing of its founding agreement (April 15, 1994; Marrakech, Morocco); see also Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT’L L. 125, 126 (2008) (discussing the Trade-Related Aspects of Intellectual Property Rights).

<sup>166</sup> See *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1251-52 (2000) (explaining that the purpose of Trade-Related Aspects of Intellectual Property Rights was “harmonizing worldwide patent law”); Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 584-85 (2012).

<sup>167</sup> Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT’L L. 125, 139 n108 (2008) (stating “for example, the Trade-Related Aspects of Intellectual Property Rights Agreement [Article 27] requires member countries to adopt patentability standards such as novelty, usefulness, and nonobviousness into their patent systems. In addition, the Trade-Related Aspects of Intellectual Property Rights Agreement [Article 28] requires an issued patent to confer a right on the patentee to exclude others from ‘making, using, offering for sale, selling, or importing’ the patented invention. Further, [article 29] requires that the patent application contain enabling language that will allow one skilled in the art to carry out the invention and indicates that a patent applicant may be required to disclose what he knows to be the best mode for carrying out the invention. Another key requirement [in article 33 is that] member countries must incorporate into their patent systems is the patent term of twenty years running from the filing date.”).

<sup>168</sup> See *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1251-52 (2000) (discussing implementation and impact of Trade-Related Aspects of Intellectual Property Rights); see also 35 U.S.C.A. § 271(a) (West 2012).

<sup>169</sup> See *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1253 (2000).

<sup>170</sup> *Id.*



### *D. The America Invents Act*

Most recently, the America Invents Act has brought the United States even closer to the rest of the world.<sup>171</sup> Curiously, the America Invents Act was not implemented in response to any international obligations, but was rather a unilateral move by the United States to bring domestic patent law more in line with the patent law of other countries.<sup>172</sup> There are two very significant changes in the America Invents Act that advance the harmonization of United States patent law with the rest of the world. The first one is the adoption under the America Invents Act of the first-inventor-to-file priority rule.<sup>173</sup> Prior to the implementation of the first-inventor-to-file rule, United States law was inconsistent with the rest of the world.<sup>174</sup> The obvious benefit of bringing United States priority filing rules in line with the rest of the world is the increased harmonization in international patent law.<sup>175</sup> The second significant change implemented by the America Invents Act is a post-grant review period.<sup>176</sup> The post-grant review is a process by which any person can request cancellation of the patent claims.<sup>177</sup> This process is very similar to the opposition proceedings under European law, which allows a period after a patent is issued for the public to bring a request for cancellation.<sup>178</sup> Like the first-to-file rule change, the post-grant review further advances the harmonization of patent law between the United States and the rest of the world.

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<sup>171</sup> See Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified in scattered sections of 35 U.S.C.); see also Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 589 (2012) (discussing several provisions of the America Invents Act).

<sup>172</sup> Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified in scattered sections of 35 U.S.C.) (stating “[t]he sense of the Congress that converting the United States patent system from “first to invent” to a system of “first inventor to file” will improve the United States patent system and *promote harmonization* of the United States patent system with the patent systems commonly used in nearly all other countries throughout the world with whom the United States conducts trade and thereby promote greater *international uniformity* and certainty in the procedures used for securing the exclusive rights of inventors to their discoveries.” (emphasis added)); See also Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 589 (2012) (noting that the AIA was an entirely unilateral measure by the United States).

<sup>173</sup> See 35 U.S.C.A. § 102(a) (West 2012) (defining that a person is entitled to a patent so long as that invention has not been already claimed by someone else before the filing date); Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified in scattered sections of 35 U.S.C.).

<sup>174</sup> See Kelly C. McKinney, *The Patent Reform Act of 2007 and International Patent Law Harmonization*, 31 HOUS. J. INT’L L. 125, 141 (2008) (discussing the first-to-file rule in countries other than the United States); see eg., European Patent Convention, art. 60, Oct. 5, 1973 (amended 2000),

<sup>175</sup> See *Id.* (discussing the benefits of a first-to-file rule).

<sup>176</sup> See 35 U.S.C.A. §§ 321-29 (West 2012) (implementing the post-grant review); see also Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 589-90 (2012) (discussing the America Invents Act post-grant review).

<sup>177</sup> See 35 U.S.C.A. § 321 (West 2012) (defining the post-grant review); see also Timothy R. Holbrook, *Should Foreign Patent Law Matter?*, 34 CAMPBELL L. REV. 581, 589-90 (2012) (discussing the America Invents Act post-grant review); Tracie L. Bryant, *The America Invents Act: Slaying Trolls, Limiting Joinder*, 25 HARV. J.L. & TECH. 687, 695 (2012).

<sup>178</sup> See European Patent Convention, art. 99, Oct. 5, 1972 (implementing the procedure for patent opposition).

A View of the Presumption Against Giving Foreign Patent Decisions Preclusive Effect in United States Proceedings in Light of Patent Law International Harmonization

*E. Differences with Respect to Patentability*

In the United States to be eligible for a patent it has to meet certain subject matter eligibility factors.<sup>179</sup> In the United States, whether you can get a patent for something depends on inventing or discovering any new and useful process, machine, manufacture, or composition of matter, or making an improvement on an existing invention.<sup>180</sup> The European Union and Japan are not so different from the United States when it comes to focusing subject matter patentability on industrial applications. The European Union, through the European Patent Office, unlike the United States, does provides for specific exclusions like computer programs, aesthetic creations, or process improvements.<sup>181</sup> Japan differs from the United States because their statute focuses on what is not actually eligible to receive a patent, compared to focusing on what can actually be patented. Japan focuses on the novelty of the subject to be patented specifically.<sup>182</sup>

Novelty (35 USC 102)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,”<sup>183</sup> Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.”<sup>184</sup> The Examiner has the burden of establishing a *prima facie* case of anticipation, see *In re Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986). Comparing this to other jurisdictions, there is a clear distinction when looking at the United States and the European Union.

In the European Union, something is novel if it is not part of the state of the art. This means that it cannot be something that has been made available to the public before the filing date with the European Patent Office.<sup>185</sup> Japan provides a broader recognition to patents already in existence elsewhere in the world.<sup>186</sup> Japan will only issue a patent if the subject has not been publicly known, worked on, or been in a distributed publication in Japan or any other country.<sup>187</sup>

Non-obviousness (35 USC 103)

In the US, obviousness is a question of law based on underlying factual inquiries. The United States Supreme Court in *Graham v. John Deere and Co.*, set forth factual inquiries which must be considered in applying the statutory test for obviousness as follows: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.<sup>188</sup> These *Graham* factual inquiries are controlling in any obviousness analysis and must be met in order to support a *prima facie* case of

<sup>179</sup> 35 U.S.C.A. § 101 (West 2012).

<sup>180</sup> *Id.*

<sup>181</sup> European Patent Convention, art. 52, Oct. 5, 1973 (amended 2000).

<sup>182</sup> Patent Act, Chapter 2, Article 29, Act No. 121 (1959) <http://www.japaneselawtranslation.go.jp/law/detail?id=2828&vm=04&re=02>.

<sup>183</sup> *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628 (Fed. Cir. 1987).

<sup>184</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

<sup>185</sup> European Patent Convention, art. 52, Oct. 5, 1973 (amended 2000).

<sup>186</sup> Patent Act, Chapter 2, Article 29, Act No. 121 (1959) <http://www.japaneselawtranslation.go.jp/law/detail?id=2828&vm=04&re=02>.

<sup>187</sup> *Id.*

<sup>188</sup> *Graham v. John Deere and Co.*, 383 U.S. 1, 17-18 (1966).

obviousness. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). How does this compare with other jurisdictions?

The European Patent Office requires that an invention must be novel and involve an inventive step.<sup>189</sup> This corresponds to United States requirements of novelty and non-obviousness in 35 U.S.C. 102 and 103, respectively.

The European Patent Office (EPO) uses a problem-solution approach for determining whether there is an inventive step. Under the EPO's approach, an invention requires an inventive step if the invention solves a technical problem in a non-obvious way.<sup>190</sup> The differences between the closest prior art to the invention are compared to determine a problem that is solved by the invention. The approach then assesses whether the differences would be obvious to a skilled person when solving the technical problem based on the prior art.<sup>191</sup>

## V. CONCLUSION

Despite the strong presumption of territoriality in patent law, the rapid and still growing globalization and internalization of markets and intellectual property has put great pressure on that presumption. Furthermore, international agreements have contributed greatly to the harmonization of international patent law. Although the Federal Circuit has not declared a *per se* rule to exclude a foreign patent decision from United States litigation, it has consistently found that foreign patent decisions are not preclusive, and has given them no relevance or weight in considering the validity of a counterpart United States patent. The Federal Circuit's rationale has been almost exclusively that that theories and laws of patentability vary from country to country. Therefore, there exists a strong presumption against giving preclusive effect to foreign patent decisions in United States proceedings. Nonetheless, it is clear that the Federal Circuit has not closed the door completely on that issue. Thus, when the global patent regime becomes truly harmonized, the Federal Circuit might be more willing to do away with that presumption and give preclusive effects foreign decisions in United States proceedings.

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<sup>189</sup> European Patent Convention, Part II, Chapter I, Article 52.

<sup>190</sup> *Id.*

<sup>191</sup> *Id.*